

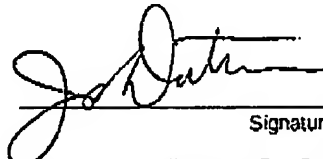
Doc Code: AP.PRE.REQ

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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 25323A	
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		First Named Inventor Walrath	
		Art Unit 1773	Examiner Tarazano
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
I am the			
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		James J. Dottavio Typed or printed name	
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>40,360</u>		<u>740/321-7167</u> Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<u>April 12, 2006</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

George A. Walrath

Serial No.: 10/611,767

Group Art Unit: 1773

Filed: July 1, 2003

Examiner: Donald L. Tarazano

For: EXTRUDED VARIEGATED PLASTIC SIDING PANELS

Attorney Docket No.: 25323A

I hereby certify that this correspondence is being transmitted via facsimile to Central FAX number  
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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is a Pre-Appeal Brief Request for Review of the final rejection presented in this patent application. Upon carefully considering the following comments, it is believed the panel of Examiners will find that the Office has failed to show proper motivation for making a modification in the obviousness rejection.

In the final rejection of claims 1-51 under 35 U.S.C. §103(a) over a single reference, Dorchester et al USP 5,869,176 (the '176 patent).

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Claim 1 of the present application reads

1. A variegated polymeric article comprising:  
a tinted substrate; and  
a substantially clear capstock layer applied onto said tinted substrate, said substantially clear capstock layer having a plurality of accent color streaks and a polymeric capstock material.

The Examiner noted three differences between the claims and the '176 patent, namely (ref. para. 7 of the Office Action):

- a. the applicants require a transparent surface layer;
- b. the claimed temperatures; and
- c. the particular materials used.

The Examiner stated in paragraph 8 of the Office Action that applicants claimed "transparent surface layer with accent particle streaks is not a patentably distinct structure ... (as) [t]he prior art clearly teaches that the pigments in the surface layer can be varied so it would have been obvious to one having ordinary skill in the art to have carried the combination of materials used based on what appearance was desired. This would include having a transparent surface layer with accent colors as claimed."

It should be noted that throughout the '176 patent, that the capstock is taught to have varying levels of "background" color as the Examiner notes, but throughout, the capstock is colored either through the use of a pigmented base material, the PMS in the color pellets coloring the capstock, or a combination of the two. Furthermore, in column 6, lines 48-52 of the '176 patent, it expressly states: "[i]n the preferred system disclosed above, the accent color patterns are introduced into the capstock, since only the capstock forms the externally exposed portion of the siding"

– noting that substrate is not visible (i.e. the capstock is not be clear).

Nowhere in the '176 patent is it taught or suggested to have a clear capstock in combination with the other claimed limitations. In fact, the continuous reference to a colored capstock teaches away from the instant invention.

This is in direct contradiction to the claimed invention, as explained in the specification on page 2 in the paragraph at the top of the page (continued from the preceding page). Applicant distinguished the prior art, including the '176 patent, in that the prior art to date fails to provide a product having depth of color or adequate weathering properties. Applicant's use of the tinted color in combination with the clear capstock has accomplished previously unavailable depth and realistic woodgrain products. Further, as stated in the paragraph at the bottom of page 2, Applicant's invention has eliminated an edge viewing concern of the prior art.

It is well established that the Office must present "a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." See *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). This is certainly not a convincing line of reasoning. First it is noted that one cannot simply obtain a clear capstock where the prior art does not teach or suggest a non-accented capstock.

Further, the Examiner states in paragraph 9 of the Office Action that "the variations of the melting/softening points of the resins would merely relate to the appearance of the final product and the degree of blending... [t]hese types of selections would be well within the ordinary skill of the art and would have been obvious based on the appearance desired". As the

Examiner does not point to specific limitations, these are not argued individually here.

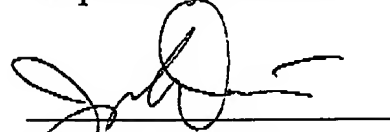
Nowhere does the Examiner provide support for the claimed limitations, and furthermore, since nobody ever made the combination of the clear capstock in combination with the claimed ranges, it is difficult for Applicant to understand how such a combination would have been obvious, particularly in view of the fact that the industry has sought to achieve a realistic woodgrain appearance as suggested by the Examiner, but has been unable to do so until the claimed invention. As noted above, the prior art (namely the '176 patent) has taught combinations which would melt the pellets to provide a background color to the capstock, and as such teaches away from the instant combination which avoids this phenomenon, and as such if the '176 patent were modified as proposed, it would be rendered unsatisfactory for its intended purpose of providing the exposed portion of the siding product (the substrate is not visible in the '176 patent) as noted above.

It is well established that there is no suggestion or motivation to make a proposed modification where the proposed modification renders the prior art invention unsatisfactory for its intended purpose (see *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Accordingly, the rejections are improper and should be withdrawn.

In summary, the Office has failed to show proper motivation for making a modification in an obviousness rejection. Upon careful review and consideration of these remarks it is believed that the panel will agree with this proposition. The early issuance of the panel's decision with respect to this request is earnestly solicited.

If any fees are required in respect to this request, please debit from  
Deposit Account 50-0568.

Respectfully submitted,

  
James J. Dottavio  
Reg. No. 40,360

Dated: 4-12-06

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